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LAW OFFICES
JENNISON & SHULTZ, P.C.
CRYSTAL PLAZA #1 - SUITE 1102
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VIRGINIA 22202-3604

ELLSWORTH M. JENNISON
KATHRYN JENNISON SHULTZ
JOHN N. JENNISON
CARL E. JENNISON

TEL: (703) 415-1640
FAX: (703) 415-0788
EMAIL: jennisonlaw@aol.com

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May 16, 2002

Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Washington, D. C. 20231

Attention: Ronald Hack, Deputy Chief Information Officer for
Information Technology Services

Re: Proposed Plan for an Electronic Public Search Facility

Normally at public hearings a speaker gives thanks for the opportunity to speak. I am not here to thank the bureaucrats who, by caveat, have erroneously determined that the paper search records of the Patent and Trademark Office Crystal City Patent Search Room and Trademark Search Library are no longer needed for public reference. I fear that a decision has already been made. I think that would be disrespectful to the purposes of holding public hearings, such as this one.

We are members of a law firm that specializes in trademark law. Members of our firm have been using the Trademark Search Library of the United States Patent and Trademark Office since 1939. In addition, members of our family have been associated with the USPTO and its predecessor agencies since 1909. Therefore, we have had a close relationship with the workings of the trademark search facilities for close to a century.

Based on our knowledge and experience, we are very aware of the value of the data contained in the public search records. We are familiar with the many reasons that the public needs and uses the information contained in the records through our continuous relationships with and representations of individuals as well as small and large companies and corporations. In addition, we are and have been the Washington associates for many U.S. and international firms. We understand the need for maintaining the integrity of the valuable resources located in the public records of the USPTO. As a result of our constant daily working with the records, both automated and paper, maintained by the agency, we have been able to study the benefits and the problems that appear in each of the formats.

Under Secretary of Commerce and
Director of the U.S. Patent and Trademark Office
Attention: Mr. Ronald Hack

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We do not object to the development of a plan to remove the trademark classified paper files from the public search facilities, provided that prior to the plan's implementation and removal of any paper files, the USPTO must completely demonstrate to the satisfaction of the user-public and the Congress that the automated records that replace the paper files are complete, up-to-date and reliable with respect to all of the data currently maintained in the non-automated records.

To date, the USPTO has been unable and unwilling to publicly make that demonstration.

Discrepancies in Search Results

A simple comparison of two exact mark searches illustrates the lack of reliance and accuracy of the X-search system and the lack of federal trademark notice of complete reliance on the automated records. Attachment A shows Registration No. 1,377,536 for the service mark of the letters "R F" with a design of a shield, house and stars. The registration is searchable and locatable under the letters and, for example, the house 'buildings and scenery' design, in the paper search room records. By contrast, a review of the automated record displays the service mark as consisting of only the letters "R F." No design elements are searchable, therefore in the automated records, the design has no trademark notice to potential users of confusingly similar marks.

Attachment B displays Registration No. 1,585,102 for the letter "O" with geometric horizontal lines, shadows and a leaf design. The trademark is searchable and locatable in the paper records as the letter "O", the design element 'bars' and the vegetation element. The automated records, by comparison identifies a pseudo mark as a letter "O" and does not identify the actual mark as an "O." Further, only the leaf design element is entered in the design field of the mark. In other words, an electronic search record of the Ohio State University "O" with lines registration is incomplete.

Of course, many more examples may be given, but I am not up here to belabor the point that when something is not right, it is wrong. The examples simply illustrate that the electronic system is not complete, not accurate and not reliable enough, at this time, to justify the elimination of the paper search records.

This is a lesson previously taught to but not learned by the PTO. Attachment C is a copy of the Government Accounting Report (GAO/IMTEC-91-1) dated October 1990 that identifies historical data quality problems at page 5 under the heading "Data Base Inaccuracies May Compromise Quality of Registration Process"

The GAO report brought to mind Assistant Commissioner of Trademarks Margaret Laurence's quote that "We (Trademarks) wanted to automate in the worse way, and we did."

Equivalence and Completeness of Systems

Another point of controversy over the plan to eliminate the Trademark Search Library paper records is that it fails to meet any obvious test of comprehensibility or coherence. It is a façade of rationality. The Federal Notice glosses over the pending application and abandoned application searchable records. By citing Section 41(i)(1) of Title 35 of the United States Code, the PTO states that it is only responsible for maintaining trademark registrations arranged to permit search for and retrieval of information. That responsibility is not met with only the automated records.

a. Historical Completeness

There is no equivalence of the completeness of the automated records versus the paper records. The automated records only carry the registration and application records from 1983 to date, and many of these records are missing and incomplete. We have also discovered and reported to PTO that information has been inexplicably purged from the automated search system. It is the paper collection records with its microfilm of canceled and expired trademarks that are arranged to permit search for and retrieval of information on all trademarks from the first registration to those issued two days ago. The automated records hold 19 years of trademark registrations; the paper search record system holds over 100 years of search and retrieval on all trademark registrations and applications. The classified paper records maintain registration certificates, application drawings, and registration and application status data that are not available in the automated system. They also maintain amendment, assignment, consent, correction and status information that the Office has failed to capture and maintain in the automated search and status systems. Attachment D is an example of an amendment to a design trademark entered in the paper search records, but missing from the automated system.

b. Statutory Notices

The Federal Notices misleadingly states that the "database also includes the marks protected under Article 6ter of the Paris Convention." Attachment E displays the Convention mark by the WIPO for European Atomic Energy Community (EURATOM) as missing from the automated records, but with full copy of notice and image from the paper records. The PTO acknowledges this shortcoming in the TMEP§ 1205 "Copies are filed in paper records of the Trademark Search Library, and pertinent information is entered in the automated search records...However, since many of the images associated with these entries are not currently available by computer, they must be found in the

Search Library."

Further statutory notices, including United States Government agency notices under Executive Order 11628 have been filed and maintained throughout the paper records. Attachment F shows a typical government agency notice for the Federal Bureau of Investigation. No such notice exists in the automated records, and if the paper records are eliminated, none will exist as statutorily required. The missing electronic notices bring into question the agency's commitment to providing the government mandated information to the public.

From the trademark examining attorney's perspective, the only relevant trademark information is the live trademark registrations and applications. But from the public's need for research, the entire collection is needed and only the paper records at this time permit the search and retrieval of all trademark information. In order to provide our clients with the most comprehensive and accurate information from the public records, we conduct searches of the paper and the automated records currently maintained in the Trademark Search Library. Yes, we continue to find discrepancies in both formats. We have documented and reported thousands of references inexplicably missing from the automated records or that are incorrect in the paper records. The problem is caused by several factors, including input errors, data maintenance and the limited capability to retrieve the information from the automated search systems. Neither system is equivalent of the other.

Negative Impact to the Public

In our opinion, officials looking into the subject issue do not fully understand how the Trademark Search Library is used. The Office is only concerned with 2(d) citations. They do not have any use for information relating to abandoned applications or canceled or expired registrations; therefore, they do not maintain this information indefinitely in the automated records. It is maintained, however, in the paper records and the microfilm records in the Search Library. These records provide valuable information in the areas of possible common law use, marks that have run into problems in the past and ownership questions.

The public needs a comprehensive search system that provides completeness. The electronic system does not provide the completeness, at this time. Only a search system incorporated from components of the electronic, paper and microfilm records provides the most complete records and meets the need of the public. At the present time, however, our clients will be damaged by the elimination of the classified paper drawings and registrations because the automated records alone fail to give notice of trademark rights.

As experts in the field of trademarks, we certify that the implementation of the

plan to eliminate the paper search record system will negatively impact the public.

Good Faith Issue

We are deeply disappointed and concerned by the attitude recently shown by the agency. For centuries the intent of a trademark from common law to statutory protection is to give notice of claimed rights. For over one hundred years the agency has maintained the paper records with full support for ensuring the best public trademark notice possible. Any decision to eliminate the classified paper search records is premature at best. Anyone with first hand knowledge on the how poorly the automation search systems have been developed and implemented is horrified that the best possible back up system will be eliminated. The hasty decision to eliminate the paper records will make waste.

This administration departs from the best information available, regardless of the medium. This administration now wants all things electronic and proposes to shirk its agency responsibility of maintaining public notice to obtain the electronic environment. Those of us who use the records in the Trademark Search Library know that great harm will be done throughout the trademark world by the callous approach being considered. It is our opinion that anyone who conducts a search without using both the paper and electronic records may be negligent. Further, while the Trademark Office is not accountable for missing citations during examination, such omissions cost the public dearly in opposition and infringement costs.

Thanks

There is a PTO story that Thomas Jefferson started the shoe paper filing system for patents that was integrated into the trademark side as well. I do not think the lore is true. I suspect that some worthy public servant started the practice, but that credit was given to Jefferson. So I want to now thank the generations of exemplary public servants who have strived for and sweated over the establishment and maintenance of the paper records of the Patent and Trademark Office. Whether it was Carl Jennison, my grandfather, or Harold Pitta, Cathy Terry or Virginia Johnson, it is their efforts that were true to the notice requirements of the American public. It is their efforts that the present administration should consider and compare themselves to for justification.

These comments were prepared by Kathryn Jennison Shultz, John N. Jennison, Carl E. Jennison.

Respectfully submitted,

Law Offices of
Jennison & Shultz, P.C.